

REMARKS

Claims 1-35 are currently pending in the application. No claims are added, canceled, or amended in this paper.

Erickson Fails to Anticipate Amended Claims 1-35

Claims 1-35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,014,644 to Erickson ("Erickson"). Applicant respectfully asserts that Erickson fails to disclose every limitation of each of the rejected claims in the same relationship to one another as set forth in each of the rejected claims.

Independent claim 1 recites an electronic commerce system comprising "one or more document repositories operable to store a plurality of transactional user documents used during a first electronic commerce transaction" and "an intelligence module operable to update one or more sections in the user documents with information related to a second electronic commerce transaction."

The Office alleges that Erickson's databases 24, 34, and 36 are the claimed document repositories.¹ Erickson, however, discloses that databases 24, 34, and 36 store "information about various buyers, suppliers, products, and services."² The claimed document repositories, however, store transactional user documents used during a first electronic commerce transaction. Absent some teaching in Erickson that its databases store transactional user documents used during a first electronic commerce transaction, Erickson cannot anticipate the present invention, as set forth in claim 1. An anticipating reference, by definition, must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim.³ Erickson fails to meet this

¹ Detailed Action, p. 2, ll. 12-13.

² Erickson, col. 2, l. 67, through col. 3, l. 1.

³ *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990).

standard. For at least this reason, it is respectfully requested that the rejection of claim 1 and the claims dependent thereto be reconsidered and withdrawn.

The Office further alleges that “[b]y maintaining these databases the reference shows that this information saved in the database is used (reissued) for a current (first) transaction and future (second) transaction.”⁴ Irrespective of whether Erickson maintains the databases, Erickson fails to disclose or suggest that any of the information is updated with information related to a second electronic commerce transaction. Moreover, even if the information in Erickson’s databases is updated with information related to a second electronic commerce transaction, Erickson fails to disclose or suggest that any of the information stored in the databases are transactional user documents, as required by claim 1. Thus, for at least these additional reasons, Erickson cannot anticipate the present invention, as set forth in claim 1. It is, therefore, respectfully requested that the rejection of claim 1 and the claims dependent thereto be reconsidered and withdrawn.

Independent claim 11 recites a method comprising the steps of “storing a plurality of transactional user documents, used in a first electronic commerce transaction, in one or more document repositories” and to “reissuing the user documents updated with information related to a second electronic commerce transaction.”

As discussed above, Erickson fails to disclose or suggest transactional user documents used in a first electronic commerce transaction. Thus, Erickson cannot disclose or suggest storing these documents or updating the documents with information related to a second electronic commerce transaction. For at least these reasons, Erickson fails to anticipate the present invention, as set forth in claim 11. It is, therefore, respectfully requested that the rejection of claim 11 and the claims dependent thereto be reconsidered and withdrawn.

⁴ Detailed Action, p. 3, ll. 1-3.

Independent claim 23 recites software operable to “store a plurality of transactional user documents, used in a first electronic commerce transaction, in one or more document repositories” and to “reissue the user documents updated with information related to a second electronic commerce transaction.”

Claim 23 is allowable over Erickson for at least the same reasons set forth above concerning claim 11. It is, therefore, respectfully requested that the rejection of claim 23 and the claims dependent thereto be reconsidered and withdrawn.

Independent claim 35 recites a system comprising “means for storing a plurality of transactional user documents used in a first electronic commerce transaction” and “means for reissuing the user documents updated with information related to a second electronic commerce.”

Claim 35 is allowable over Erickson for at least the same reasons set forth above concerning claim 1. It is, therefore, respectfully requested that the rejection of claim 35 be reconsidered and withdrawn.

Concerning the rejected claims, Applicant respectfully requests that the Office indicate wherein Erickson expressly recites a transactional user document used in a first electronic commerce transaction and updated with information from a second electronic commerce transaction. If no such express disclosure is provided by Erickson and the Office wishes to allege that Erickson’s information inherently includes transactional user documents used in a first electronic commerce transaction and updated with information from a second electronic commerce transaction, Applicant respectfully requests that the Office provide some scientific evidence or scientific reasoning to establish the reasonableness of the belief that the limitation is inherent in Erickson. If neither of these standards can be met, a *prima facie* case of anticipation cannot be established. If no *prima facie* case of anticipation can be established, Applicant respectfully requests a Notice of Allowance be issued, allowing all of the pending claims.

Accordingly, it is respectfully requested that the rejection of claims 1-35 under 35 U.S.C. § 102(b), as being anticipated by U.S. Patent No. 6,014,644 to Erickson, be reconsidered and withdrawn.

The Legal Standard for Anticipation Rejections Under 35 U.S.C. § 102

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.
2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.
5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.
6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.
4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating

anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce

the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental

to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

CONCLUSION

Note that Applicant has merely discussed example distinctions from the various references cited by the Office. Other distinctions may exist and Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal. By not responding to the additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The remarks provided above are sufficient to overcome the Office's rejections.

Applicant submits that all of the Examiner's rejections are hereby traversed and overcome. The Applicant respectfully submits that the Examiner has not shown by clear and convincing evidence that the claimed invention would have been anticipated by Erickson. For the reasons set forth herein, the Applicant submits that claims 1-35 are in condition for allowance, and respectfully requests that claims 1-35 be allowed. The Examiner, however, is encouraged to call Applicant's representative, Daren Davis, at 817-578-8616, if he wishes to further explore the merits of the pending claims.

No fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any fees which may be required, or credit any overpayments, to Deposit Account No. **500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

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Date

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